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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/742,305	12/18/2003	John P. Miller	F-772	5695

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EXAMINER

GHATT, DAVE A

ART UNIT PAPER NUMBER

2854

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/742,305

Applicant(s)

MILLER ET AL.

Examiner

Dave A. Ghatt

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 21-26 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10-16 is/are allowed.
- 6) ☒ Claim(s) 1-6, 17 and 18 is/are rejected.
- 7) ☒ Claim(s) 7-9, 19 and 20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/22/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claims 21-26 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Applicant timely traversed the restriction (election) requirement in the reply filed on January 14, 2005.

2. Applicant's election with traverse of claims 1-20 in the reply filed on January 14, 2005 is acknowledged. The traversal is on the ground(s) that the search areas overlap each other and that there is no undue burden involved in examining all pending claims. This is not found persuasive because as outlined in the restriction requirement, the process of registering a surface of a mail piece can be practiced by another materially different apparatus, one that does not include an actuator. Because these inventions are distinct for the reasons given above, the search of all the claims would seriously burden the examining process. As such, the restriction is proper.

3. The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Ansell et al. (US 6,692,166). As shown in Figure 2, Ansell et al. teaches the claimed registration system. As shown in Figure 2, Ansell et al. teaches a first biasing means 8 to apply a biasing force to an article 9 to register the article against a registration plate 10 during printing by a first print head 12. Figure 1 of Ansell et al. teaches an actuator means, shown generally at 5 (trapezoidal element), coupled to the first biasing means 8, the actuator means shown generally at 5, controlling a position of the first biasing means 8 to selectively apply and remove the biasing force.

With respect to claim 2, insofar as structure is defined, Ansell et al. teaches the first biasing means being a ski 8.

With respect to claim 3, as shown in Figure 2, Ansell et al. teaches a the ski formed of a flexible material, shown at 15.

With respect to claims 4 and 5, as shown in Figure 1, Ansell et al. teaches the actuator means being a rotary actuator that when rotated controls the position of the biasing means, via gearing 6. As shown in Figure 1, the rotary actuator (shown generally at 5) includes a motor shaft.

With respect to claim 6, as outlined in column 5 lines 5-11, the biasing force is applied only during imprinting.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ansell et al. (US 6,692,166) in view of Gregoire (US 6,048,048). Figure 2 of Ansell et al. teaches a mailing system for processing mail pieces including printing on an upper surface of a mail piece passing through the mailing system. As shown in Figure 2, Ansell et al. teaches the mailing system comprising a first printing device including a first print head 12 disposed in a predetermined plane to deposit ink on the upper surface of a mail piece 9. Ansell et al. also teaches a registration plate 10 arranged to register the upper surface of a mail piece 9 at a predetermined distance beneath the first print head 12. With respect to the requirement for a transport device, insofar as structure is recited, Ansell et al. also teaches this requirement. Figure 2 shows a transport device 13 to manually transport a mail piece 9 under the print head 12. Insofar as structure is recited, Figure 2 of Ansell et al. teaches a first ski 8, to apply a biasing force to a lower surface of the mail piece 9 to register the upper surface of the mail piece against the registration plate 10 beneath the first printing device. Anse et al. Also teaches an actuator device (trapezoidal device shown generally at 5 in Figure 1) coupled to the first ski 8, the actuator device controlling a position of the first ski 8 to selectively apply the biasing force when the first printing device is printing on the mail piece and to remove the biasing force when the

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printing has been completed by the first printing device 12. In fact, Ansell et al. teaches all the claimed structure, including a print head 12. However, Ansell et al. is silent as to whether the print head is an ink jet head with nozzles. As shown in Figure 2, Gregoire teaches a mailing system similar to that of Ansell et al. As taught in the abstract, the apparatus includes an ink jet print heads having a plurality of nozzles. To one of ordinary skill in the art, it would have been obvious to include the ink jet print head with nozzles as taught by Gregoire, in the apparatus of Ansell et al., in order to improve the quality of the prints, as taught by Gregoire in column 2 lines 18-34.

With respect to claim 18, the primary reference Ansell et al. teaches the claimed structure. As shown in Figure 1, the actuator device includes a motor 5 having a shaft, the shaft being coupled (via gears 6) to the first ski by a linking mechanism 8, wherein rotation of the shaft by the motor in a first direction causes the first ski to move into a first position to apply the biasing force, and rotation of the shaft by the motor in a second direction opposite the first direction causes the first ski to move into a second position to remove the biasing force.

Allowable Subject Matter

8. Claims 7-9, 19, and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 7 is indicated as having allowable subject matter because the prior art of record does not teach or render obvious the total combination claimed, including a second biasing

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means coupled to the actuator means, wherein a position of the actuator means determines which one of the first and second biasing means will apply the biasing force.

Claim 19 is indicated as having allowable subject matter because the prior art of record does not teach or render obvious the total combination claimed, including a second ski to apply a biasing force to a lower surface of the mail piece to register the upper surface of the mail piece against the registration plate beneath the second printing device, the second ski being coupled to the actuator device, wherein only one of the first and second printing device is active at a time,

Claim 20 is indicated as having allowable subject matter because the prior art of record does not teach or render obvious the total combination claimed, including a sensor to detect when a trailing edge of the mail piece is passing the first printing device, wherein the actuator device in response to the trailing edge being detected positions the first ski to apply the biasing force for a next mail piece.

9. Claims 10-16 are allowed.

Claim 10 was indicated as having allowable subject matter because the prior art of record does not teach or render obvious the total combination claimed, including a second print module located along the feed path downstream from the first print module, only one the first and second print modules being active at a time, a second biasing means to apply a biasing force to the article to register the article against the registration plate during printing by the second print module, and an actuator device coupled to the first biasing means and the second biasing means, the actuator device controlling a position of the first and second biasing means to selectively apply and remove the biasing force.

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Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave A. Ghatt whose telephone number is (571) 272-2165. The examiner can normally be reached on Mondays through Friday 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew H. Hirshfeld can be reached on (571) 272-2168. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DAG



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